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EXAMINER
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* PAUL A. LOTKE

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Appeal 2014-006028  
Application 12/480,350  
Technology Center 3700

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Before LINDA E. HORNER, BRANDON J. WARNER, and  
LEE L. STEPINA, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Paul A. Lotke (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–9, 12–14, 21–23, 25, and 26, which are all the pending claims. Appeal Br. 1. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).<sup>1</sup>

We REVERSE.

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<sup>1</sup> An oral hearing scheduled for October 21, 2016, has been waived due to Appellant’s failure to file within 21 days any response to the Notice of Hearing, dated August 12, 2016, or to appear at the hearing as scheduled.

### CLAIMED SUBJECT MATTER

Appellant's disclosed invention relates generally to "prosthetics for knee replacement," and more particularly to "a prosthesis for replacing the articulating surfaces of the knee." Spec. ¶ 3. Claims 1, 12, and 21 are independent. Claim 1, reproduced below with emphasis added, is illustrative of the subject matter on appeal.

1. A knee prosthesis for covering a portion of a patient's patella, and trochlear groove and intercondylar notch of the femur, comprising:

a patellar prosthesis configured to cover a posterior surface of a patella; and

*a femoral prosthesis* comprising:

a body having a posterior surface configured to cover a portion of the trochlear groove and an anterior surface forming a groove that is cooperable with the posterior surface of the patellar prosthesis;

and at least one of either:

a medial extension having a *posterior surface configured to engage a portion of the intercondylar notch* of the patient, wherein the medial extension projects away from a distal end of the body and is configured to extend along a medial edge of the intercondylar notch to engage a substantial length of the medial side of the intercondylar notch; and

a lateral extension having a *posterior surface configured to cover a portion of the intercondylar notch*, wherein the lateral extension projects away from a distal end of the body and is configured to extend along a lateral edge of the intercondylar notch to engage a substantial length of the lateral side of the intercondylar notch;

wherein the *femoral prosthesis is configured to form an articular surface between the patella and the femur without substantially overlying an articular surface between the femur and the tibia*; and

wherein the at least one extension has a length and a width at an intersection with the body, wherein the length is substantially greater than the width.

#### EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Merchant	US 6,616,696 B1	Sept. 9, 2003
Donkers	US 2003/0225458 A1	Dec. 4, 2003
Rolston	US 2004/0167630 A1	Aug. 26, 2004
Lotke	US 7,544,209 B2	June 9, 2009
Keller	DE 29 01 009 A1	July 17, 1980

#### REJECTIONS

The following rejections are before us for review:

- I. Claims 1–9, 12–14, 21–23, 25, and 26 stand rejected on the basis of obviousness-type double patenting as being unpatentable over claims 1–36 of Lotke. Final Act. 4.
- II. Claims 1, 4, 12, and 14 stand rejected under 35 U.S.C. § 102(e) as clearly anticipated by Rolston. *Id.* at 5–7.
- III. Claims 12–14, 21–23, and 26 stand rejected under 35 U.S.C. § 102(e) as anticipated by Donkers. *Id.* at 7–8.

- IV. Claims 1–9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Keller or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Keller, as evidenced by Merchant. *Id.* at 8–9.

#### ANALYSIS

*Rejection I—Claims 1–9, 12–14, 21–23, 25, and 26 as unpatentable based on obviousness-type double patenting*

The Examiner rejected the claims on the basis of obviousness-type double patenting as being unpatentable over claims 1–36 of Lotke, stating only that “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other claiming the identical knee prosthesis comprising a femoral component having the same limitations,” and noting that, with regard to the patellar component, “see at least claim 2 of [Lotke].” Final Act. 4. We agree with Appellant that a sustainable rejection has not been established, based on the observation that “[t]his bare assertion of double-patenting does not meet the Examiner’s burden of making a prima facie case of non-statutory obviousness-type double-patenting.” Appeal Br. 9; *see id.* at 9–10 (citing MPEP § 804 (which explains that the analysis required for an obviousness-type double patenting rejection is similar to that which must be undertaken for an obviousness rejection based on 35 U.S.C. § 103)).

The Examiner takes the position in the Answer that Appellant’s arguments “are untimely.” Ans. 9. This is incorrect. Appellant has the opportunity in the Appeal Brief to present argument against any and all rejections made in the action from which the appeal is taken. Although we

agree with the Examiner that Appellant's arguments "do not point out any specific patentable distinction between the current application and the stated patent," it nevertheless remains the Examiner's initial burden to set forth a proper rejection. Accordingly, we do not sustain this rejection.

*Rejection II – Claims 1, 4, 12, and 14 as clearly anticipated by Rolston*

Independent claim 1 recites, in relevant part, "a femoral prosthesis" that includes a trochlear groove body portion having "an anterior surface forming a groove" to cooperate with a posterior surface of a patellar prosthesis, and an intercondylar notch extension portion having "a posterior surface configured to engage [and/or cover] a portion of the intercondylar notch" of the bone of a patient, where "*the femoral prosthesis is configured to form an articular surface between the patella and the femur without substantially overlying an articular surface between the femur and the tibia.*" Appeal Br. 16–17, Claims App. (emphasis added). Independent claim 12 also recites "a femoral prosthesis" and includes similar limitations, including a recitation that an intercondylar notch portion of the femoral prosthesis "*is configured to form a patellar-femoral articular surface without substantially overlying a condylar surface of a femoral-tibial articular surface.*" *Id.* at 19, Claims App. (emphasis added). Appellant argues that Rolston does not disclose a femoral prosthesis that is configured to cover the intercondylar notch without extending onto condylar surfaces, as in the limitations emphasized above. *See* Appeal Br. 11–12; Reply Br. 2, 6. We agree.

In rejecting these claims as anticipated by Rolston, the Examiner relies on Rolston's femoral prosthesis component 10 as disclosing the

femoral prosthesis as recited in the claims. *See* Final Act. 6–7. Regarding the limitations emphasized above that the femoral prosthesis be configured to form an articular surface “without substantially overlying” a condylar surface, the Examiner states that Rolston meets this limitation based on the Examiner’s interpretation that a “non-replaced condyle” is not covered (substantially overlain) by the femoral prosthesis. *See id.*; Ans. 10. This interpretation misconstrues the requirements of the claims.

Although we appreciate the Examiner’s position based on Rolston’s disclosure of a prosthesis that we understand to replace either a medial or lateral condylar surface (while presumptively leaving uncovered the other condylar surface), such a prosthesis does not fall within the scope of the present claims. Considering the plain text of the limitations emphasized above, we agree with Appellant that Rolston’s prosthesis covers (substantially overlies) a condylar surface (one or more), thus violating a requirement of the claimed femoral prosthesis. *See* Appeal Br. 11–12. The fact that Rolston’s prosthetic may not also cover the other condylar surface does not change this fact.

An anticipation rejection requires a finding in a single reference of each and every limitation as set forth in the claims. As discussed above, Rolston’s disclosure falls short of this requirement. Accordingly, we do not sustain this rejection.

*Rejection III – Claims 12–14, 21–23, and 26 as anticipated by Donkers*

Similar in some respects to the discussion above, independent claim 12 recites, in relevant part, “a femoral prosthesis” that includes “an intercondylar notch portion” that “*is configured to form a patellar-femoral*

*articular surface without substantially overlying a condylar surface of a femoral-tibial articular surface.”* Appeal Br. 19, Claims App. (emphasis added). Independent claim 21 similarly recites, in relevant part, “a femoral prosthesis” that includes “an intercondylar notch portion” that “*is configured to overlie a portion of the intercondylar notch without substantially extending over an articular surface between a condyle and the tibia.*” *Id.* at 20, Claims App. (emphasis added). Appellant argues that Donkers does not disclose a femoral prosthesis that is configured to cover (overlie) the intercondylar notch without extending onto condylar surfaces, as in the limitations emphasized above. *See* Appeal Br. 12–15; Reply Br. 2–5. We agree.

In rejecting these claims as anticipated by Donkers, the Examiner relies on Donkers’s femoral component 400 as disclosing the femoral prosthesis as recited in the claims. *See* Final Act. 7–8. Regarding the limitations emphasized above that the femoral prosthesis be configured to form an articular surface “without substantially overlying” or “extending over” a condylar surface, the Examiner states that Donkers meets this limitation based on the Examiner’s interpretation of Donkers’s prosthesis “as not comprising elements 420 and 430.” Final Act. 8; *see* Ans. 10–11. This interpretation is not supported by a preponderance of the evidence.

After review of the disclosure of Donkers, we agree with Appellant that, even without condylar flanges 420 and 430, “femoral component 400 is still configured to extend over an articular surface between a condyle and the tibia.” Appeal Br. 13. Given the anatomy of a knee, it is unclear how Donkers’s femoral component 400 would not substantially overlie (extend over) a condylar surface, thus violating a requirement of the claimed femoral



prosthesis. *See id.*; Reply Br. 3–5 (both including annotated Figure 4 of Donkers). The Examiner does not explain adequately how the configuration of Donkers’s femoral component 400 (even without attaching condylar flanges 420 and 430, femoral component 400 is still sized and shaped for selective use with these modular components) would not extend over a condylar surface, which the claims prohibit. *See* Ans. 10–11.

An anticipation rejection requires a finding in a single reference of each and every limitation as set forth in the claims. As discussed above, Donkers’s disclosure falls short of this requirement. Accordingly, we do not sustain this rejection.

*Rejection IV – Claims 1–9 as anticipated by Keller or, in the alternative, as unpatentable over Keller, as evidenced by Merchant*

As discussed above, independent claim 1 recites, in relevant part, “a femoral prosthesis” that includes a trochlear groove body portion having “an anterior surface forming a groove” to cooperate with a posterior surface of a patellar prosthesis, and an intercondylar notch extension portion having “a posterior surface configured to engage [and/or cover] a portion of the intercondylar notch” of the bone of a patient, where “the femoral prosthesis is configured to form an articular surface between the patella and the femur without substantially overlying an articular surface between the femur and the tibia.” Appeal Br. 16–17, Claims App. (emphasis added). Appellant argues that Keller does not disclose a femoral prosthesis that includes an intercondylar notch extension portion with a posterior surface that is configured to engage and/or cover a portion of the intercondylar notch of the bone of a patient, or that is configured to cover the intercondylar notch

without extending onto condylar surfaces, as in the limitations emphasized above, and that Merchant does not cure the deficiencies of Keller. *See* Appeal Br. 5–9; Reply Br. 2, 6. We agree.

In rejecting these claims as anticipated by Keller, the Examiner relies on Keller’s body 19 of sliding insert 17 as disclosing the femoral prosthesis as recited in the claims. *See* Final Act. 8–9. Regarding the limitations emphasized above that the femoral prosthesis include an intercondylar notch extension portion that is configured to engage and/or cover a portion of the intercondylar notch of the bone of a patient, and that is configured to form an articular surface without substantially overlying a condylar surface, the Examiner finds that Keller discloses such an intercondylar notch extension portion “generally 20” having “self evident” medial and lateral extensions that meet these limitations. *Id.* This finding is not supported by a preponderance of the evidence.

After review of the disclosure of Keller, we agree with Appellant that femoral prosthesis 6, including sliding insert 17, is only disclosed as being configured to slide on (or engage and/or cover) other components of Keller’s total knee replacement device, such as tibial implant 5 or joint block 30. *See* Appeal Br. 6–8; Keller, Figs. 3, 4, 6, 7. Initially, we note that an examiner must give pending claims their broadest reasonable interpretation, but that such an interpretation must be consistent with the one that one of ordinary skill in the art would reach. Here, the Examiner does not explain adequately why one of ordinary skill in the art would consider Keller’s sliding insert 17, apart from the remainder of Keller’s upper prosthesis 6 that covers the end of the femur, to be a “femoral prosthesis” as claimed.

Moreover, given the anatomy of a knee, it is unclear how Keller's sliding insert 17, including bifurcated extension 20 with parallel legs 21, would be "configured to engage" or "configured to cover" a portion of the natural intercondylar notch of the bone of a patient, as required by the claims, rather than being configured to simply slide against joint block 30. *See* Appeal Br. 6–8; Reply Br. 2, 6; Keller, Figs. 3, 4, 6, 7. Although the Examiner takes the position that body 19 of sliding insert 17 "is capable of being used wherein the posterior surface of one of the extensions engages, either directly or indirectly, the intercondylar notch of the patient," such a speculative position is not supported by the disclosure of Keller, which does not show this element in relation to an intercondylar notch of a patient. Ans. 8–9. Thus, the Examiner does not explain sufficiently how the configuration of Keller's sliding insert 17 (even if considered alone) would be configured to engage and/or cover a portion of the natural intercondylar notch of the bone of a patient, or would be configured to form an articular surface without substantially overlying a condylar surface, as required by the claims. *See id.*

An anticipation rejection requires a finding in a single reference of each and every limitation as set forth in the claims. As discussed above, Keller's disclosure falls short of this requirement. Merchant is cited as evidence that it was well known to use a patellar prosthesis with a femoral prosthesis, as an alternative to the anticipation position that such inclusion of a patellar prosthesis would be inherent, but not to cure the deficiency of Keller discussed above. *See* Final Act. 9; Appeal Br. 9. Accordingly, we do not sustain this rejection.

Appeal 2014-006028  
Application 12/480,350

DECISION

We REVERSE the Examiner's rejections of claims 1–9, 12–14, 21–23, 25, and 26.

REVERSED